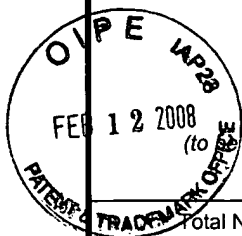


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# TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number	10/665,440
Filing Date	September 17, 2003
First Named Inventor	SKINLO, David M.
Group Art Unit	1745
Examiner Name	Cynthia K. Lee
Attorney Docket Number	Q137-US7

## ENCLOSURES (check all that apply)

Fee Transmittal Form  Fee Authorized  Amendment with Attachment  After Final  Affidavits/declaration(s)  Extension of Time Request  Express Abandonment Request  Information Disclosure Statement  Certified Copy of Priority Document(s)  Response to Missing Parts/ Incomplete Application  Response to Missing Parts under 37 CFR 1.52 or 1.53	Assignment Papers (for an Application)  Drawing(s)  Licensing-related Papers  Petition to Convert to a Provisional Application  Power of Attorney, Revocation Change of Correspondence Address  Terminal Disclaimer  Request for Refund  CD, Number of CD(s) _____	After Allowance Communication to Group  Appeal Communication to Board of Appeals and Interferences  X Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  Proprietary Information  Status Letter  X Other Enclosure(s) (please identify below): X Response to Examiner's Answer
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Respectfully submitted,

Dated: 2/12/2008

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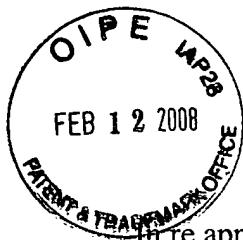
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PATENT  
Q137-US7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SKINLO, David M.

Serial No: 10/665,440

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY  
CONSTRUCTION AND METHOD OF  
MANUFACTURE

Art Unit: 1745

Examiner: LEE, Cynthia K.

CERTIFICATE OF MAILING VIA EXPRESS MAIL (37 CFR 1.10)

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Dated: February 12, 2008

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2. Response to Examiner's Answer
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Application No: 10/665,440

Docket No.: Q137-US7

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:

David M. Skinlo

Serial No: 10/665,440

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY  
CONSTRUCTION AND METHOD OF  
MANUFACTURE

Art Unit: 1745

Examiner: LEE, Cynthia K.

MS Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF TO EXAMINER'S ANSWER**

This Reply Brief is filed in response to the Examiner's Answer mailed on December 12, 2007.

**ARGUMENT**

**The Answer Does Not Establish Criticality**

As noted in the Appeals Brief, the claims stand rejected for failing to recite an allegedly critical element. In particular, the claims are rejected for failing to recite an electrically conductive terminal pin being electrically insulated from the case. MPEP §2164.08(c) provides the basis for rejections that rely on criticality. MPEP §2164.08(c) shows that in order to properly support this rejection, the specification must teach that the allegedly critical invention is critical to the operation of the invention. Accordingly, in order for MPEP §2164.08(c) to be properly applied, the specification must teach that insulation of the pin from the case is critical to the operation of the claimed method of constructing the battery.

The Examiner's Answer does not point to a single location where the specification teaches that insulation of the pin from the case is critical to the operation of the claimed method. For this reason alone, the rejection should be withdrawn.

### **The Examiner's Answer Confuses the Legal Requirements of the Rejection**

Rather than point to a teaching of criticality in the specification, the Examiner's Answer argues that the Applicant does not point to a **specific** embodiment where the pin is not insulated from the case. However, this argument confuses the legal standard necessary to support this rejection. The legal standard is not whether the Applicant discloses a specific embodiment without the allegedly critical feature but whether the Applicant teaches that the feature is critical to the claimed method. Note that MPEP §2164.08(c) states this rejection "should be made **ONLY** when **the language of the specification** makes it clear that the limitation is critical for the invention to function as intended" (emphasis added). The use of the term "**ONLY**" in this quotation emphasizes that this rejection is not proper without the specification teaching that the feature is critical to the claimed method. The Applicant failing to point to a **specific** embodiment where the pin is not insulated from the case does not establish that insulation of the pin and case is critical to the claimed method. As a result, the argument that Applicant has failed to point to a **specific** embodiment without this feature does not support the pending rejection.

### **The Examiner's Answer Impermissibly Relies on a Preferred Embodiment**

The Examiner's Answer also relies on a **preferred** construction of a pin sub-assembly to support the rejection (Page 4 of Examiner's Answer citing pg. 7, ln. 2 of specification). However, MPEP §2164.08(c) specifically states that preferred features are not critical. For instance, MPEP §2164.08(c) states that "(f)eatures which are merely preferred are not to be considered critical." The specification teaches that the cited pin sub-assembly is a preferred construction. For instance, the paragraph with the Examiner's citation begins with the statement that "FIGS. 1 and 2 ... illustrate a **preferred** feedthrough pin subassembly 10." Since the cited structure is a preferred structure, MPEP §2164.08(c) prevents the conclusion that the cited pin subassembly is critical to the operation of the claimed method. As a result, the subject matter of this citation is not critical.

The Examiner's Answer also cites the teaching that "the tab is welded to a second endcap" at page 4, lines 16-20. However, when we look at the entire quotation, we see this also

refers to a preferred embodiment. The entire quotation provides that in “accordance with a **preferred** embodiment, the tab is welded to a second endcap which is in turn welded to the case” (emphasis added). Since this quotation also refers to a preferred arrangement, MPEP §2164.08(c) also prevents the conclusion that this arrangement is a critical arrangement. As a result, the subject matter of this citation is also not critical.

Since the subject matter of the above two citations is not critical, the portion of the Examiner’s Answer relying on these citation for criticality should be removed from consideration. After we extract the material from the above two citations from the Examiner’s Answer and look at what is left, we note that the only arguments left in support of criticality cite to page 3, lines 18-20. The entire citation reads as follows:

Additionally, in the fully manufactured battery, the pin extends through a battery case endcap and functions as one of the battery terminals. **The battery case itself generally functions as the other battery terminal.** (Bold emphasis added)

Ironically, once the two citations discussed above are extracted from the Examiner’s Answer, the Examiner’s Answer primarily relies on the portion of the specification teaching that the “battery case itself **generally** functions as the other battery terminal” at page 3, lines 18-20 (emphasis added). As noted in the Appeals Brief, the term “generally” indicates a condition that is not always true. As a result, this sentence teaches that the case does not always function as the other battery terminal. Accordingly, when the material from the above two citations is extracted from the Examiner’s Answer, the Examiner’s Answer is left to rely primarily on the portion of the specification teaching that the case does not always function as the other battery terminal.

As noted in the Appeals Brief, when the case does not function as the other terminal, the pin can be in electrical communication with the case without shorting the battery. If the pin can be in electrical communication with the case, there is no reasonable argument that the specification teaches that it is critical for the pin to be insulated from the case. As a result, extraction of the above two citations from the Examiner’s Answer in accordance with MPEP §2164.08(c) largely restricts the Examiner’s Answer to a citation which actually supports the Applicant’s position. Accordingly, application of MPEP §2164.08(c) to the Examiner’s Answer shows that the Examiner’s Answer supports the Applicants position. Since the Examiner’s Answer actually shows that it is NOT critical for the pin to be insulated from the case, the claims are enabled and the rejection should be withdrawn.

### **The Examiner's Answer Impermissibly Contradicts the Specification**

Additionally, the Examiner's Answer relies on the conclusion that "since the pin is the 'one terminal' ..., 'the other terminal' is necessarily the battery case" (Examiner's Answer, page 5, last sentence of first full paragraph). **This conclusion directly contradicts the specification.** As noted above, the specification teaches that the case does not always functions as the other battery terminal. The specification teaching that the case does not always function as the other battery terminal **directly contradicts** the Examiners conclusion that "'the other terminal' is necessarily the battery case."

The second paragraph of MPEP §2164.04 specifically addresses conflicts between specification teachings and examiner assertions. MPEP §2164.04 provides the following:

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). **As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure."** 439 F.2d at 224, 169 USPQ at 370. (Bold emphasis added)

Since the Examiner's Answer reaches a conclusion that contradicts the Applicant's specification, it appears that the Examiner doubts the truth or accuracy of the Applicants specification. As a result, MPEP §2164.04 requires that the Examiner set forth an explanation of "*why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement."

No explanation has been presented as to why the Examiner doubts Applicant's teaching that the case does not always function as the other battery terminal. Additionally, no reasoning or evidence inconsistent with this teaching has been presented. As a result, the Examiner's Answer does not comply with the requirements of MPEP §2164.04 and it remains "presumptively accurate" (second paragraph of MPEP §2164.04) that the case does not always function as the other battery terminal. As noted above, when the case does not function as the other terminal, the pin can be in electrical communication with the case without shorting the battery. If the pin can be in electrical communication with the case, there is no reasonable argument that the specification teaches that it is critical for the pin to be insulated from the case. Since there is no reasonable argument that it is critical for the pin to be insulated from the case, the pending rejection is not supported and the rejection should be withdrawn.

#### CONCLUSION

The specification does not teach that it is critical for the pin to be electrically insulated from the case. Further, the arguments set forth in the Examiner's Answer do not show that insulation of the pin from the case is critical. Even further, the specification teaches that there are embodiments of the battery where the pin need not be insulated from the case. As a result, neither the specification nor the Examiner's Answer establish criticality of insulating the pin from the case and the pending rejection for lack of enablement under MPEP §2164.08(c) is not properly supported and should be withdrawn.

Respectfully submitted



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